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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/398,876	09/20/1999	UWE HANSMANN	12640(GE998-	1606

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EXAMINER

HUYNH, LEE R

ART UNIT	PAPER NUMBER
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2132

DATE MAILED: 07/23/2003

7

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/398,876	Applicant(s) HANSMANN ET AL.	
	Examiner Lee R Huynh	Art Unit 2132	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09/20/03 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
 If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☒ All b) ☐ Some * c) ☐ None of:
 1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
 * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>5</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1,2,4,11,12,13,14,15,17,19,26,27,28,29,35,36,41,42 rejected under 35 U.S.C. 102(e) as being anticipated by Diendl et al (U.S 6031910). The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

In referring to claims 1,2,28,29 Diendl et al. reference discloses the file stored in the central server or any storage medium, which is can be read if authorized. This reading process meets the description of download process initiated when the card is inserted. The reference further discloses the file comprises encrypted data, an encryption of its cryptographic key generated randomly by the chip card, and the control data (col. 3, line 20-24). The reference also discloses a chip card stores a second cryptographic key for encrypting the encrypted cryptographic key. The reference shows that after reading the file onto the terminal, the control data is transmitted to the chip card for decryption. This transmission meets the requesting process that the first information unit requests the second information unit to decrypt the first key. The decrypted key is then returned to the terminal, whereupon the terminal now uses that key to decrypt the data record (col. 5, line10-27).

In referring to claims 4,11 Diendl et al. reference discloses a key is generated randomly and is encrypted with a fixed key stored on the chip card (col. 3, line 31-35).

In referring to claims 12,13, 26,27 Diendl et al. reference discloses a terminal server coupled to a card reader accepting a portable device such as a chip card (Fig 3.) which meets the description of the first information unit as a terminal and/or a chip card reader as well as it meets the description of the second information unit as a portable device which can be a chip card.

In referring to claims 14 the claims are a system of claim 1; therefore, the claims are interpreted and rejected as set forth in claims 1.

In referring to claims 15 the claims are a system of claim 2; therefore, the claims are interpreted and rejected as set forth in claims 2.

In referring to claim 17, Diendl et al. reference discloses the control data is included in a file (col. 2, line 32-42).

In referring to claim 19 the claim is a system of claim 4; therefore, the claim is interpreted and rejected as set forth in claim 4.

In referring to claims 35,36 Diendl et al. reference discloses a computer coupled to a read/write device can interoperate with the chip card as described in col. 10, line 10-25.

In referring to claims 41,42 the claims are a program with executable codes behaving as a system of claims 1,2; therefore, the claim is interpreted and rejected as set forth in claims 1,2.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 8-10,3,7,5,6,16,18,20-25,30-34,37-40,43 rejected under 35 U.S.C. 103(a) as being unpatentable over Deindl et al. as applied to claims above, and further in view of Deo et al. U.S. Patent 5721781. In referring to claims 8-10,3,7,5,6,16 Deindl et al. reference discloses the system and method to interconnect and securely transmit the

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critical data using cryptographic process. Deindl et al. reference lacks the digital signatures and identification authentication. Deo et al. reference discloses the use of digital signature to ensure the terminal that an encrypted message stored from a central server or an internet server is really come from the smart card (see line 5-34, page 7). Deo et al. reference discloses further smart card can trust terminal's identity using the terminal acts as a certifying authority where the smart card can obtain the terminal's public key. Also, the identification information upon received from the smart card is encrypted using a certifying authority's private key. The smart card then deciphers the message using the terminal's public key to check if it is intelligible information (col. 7, line 46-67-col 8. line 1-5, page 8).

Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to add digital signature and identification authorization as taught by Deo et al. to the method and system of Deindl et al. in order to provide the authentication and integrity of the transmission message.

In referring to claims 18,30 Deindl et al. reference discloses the second secure device comprising of a non-volatile storage. Deindl et al. reference lacks the second secure device having a processor. Deo et al. reference discloses a smart card that has a build-in microcontroller, which enables the card to perform multiple functions on external devices. It would have been obvious to one of ordinary skill in the art at the time the invention was made to add a processor to the chip card of Deindl et al. in order to perform multiple functions on external devices.

In referring to claims 20,21,25 the claims are a system of claims 5,3; therefore, the claim is interpreted and rejected as set forth in claim 5,3.

In referring to claim 22,32 Diendl et al. reference discloses a chip card having an optical memory to store the critical information such as the key for encrypting the data (col. 1 line 33). However, the reference lacks the signature key. Deo et al. reference discloses a chip card storing a signature key. It would have been obvious to one of ordinary skill in the art at the time the invention was made to add a signature key to the chip card of Diendl et al. in order to enhance the level of security for the message transmission.

In referring to claims 23,24 the claims are a system of claim 8,9; therefore, the claims are interpreted and rejected as set forth in claim 8,9.

In referring to claims 33,34 the claims are a chip card of claim 23,24; therefore, the claims are interpreted and rejected as set forth in claims 23,24.

In referring to claim 31 the claim is a chip card of claim 21; therefore, the claim is interpreted and rejected as set forth in claim 21.

In referring to claims 37-40 Diendl et al. reference discloses the computer coupled to a read/write device can download software module comprising encrypted data and a key for encrypting that data. The reference lacks the digital signature. Deo et al. discloses a terminal accepting a chip card can store the data with chip card's signature and a signature key. Deo et al. disclose further that the terminal can trust chip card's identity using the chip card as a certifying authority where the terminal can obtain the chip card's public key. Also, the information upon received from the chip card is

encrypted using a certifying authority's private key. The terminal then deciphers the message using the chip card's public key to check if it is intelligible information (col. 7, line 46-67-col 8. line 1-5, page 8). If it is, the terminal can read the file comprising the data with chip card's signature on and chip card's signature. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to add digital signature and external authentication to the chip card reader of Diendl et al. in order to provide the authentication and integrity of the transmission message.

In referring to claim 43 the claim is a program with executable codes behaves as a system of claim 3; therefore, the claim is interpreted and rejected as set forth in claim 3.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. Hopkins U.S. Patent 5757918 discloses a process to authenticate a smart card and verify smart card's identity.

b. Yee et al. U.S Patent 5781723 discloses a system and method to interoperate smart card and terminal providing secure communication transaction among the said system.

c. Fox et al. U.S Patent 5790677 discloses a system and method for secure electronic transaction involving smart cards, terminal, and storage media.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lee R Huynh whose telephone number is 703-305-7395. The examiner can normally be reached on Mon-Fri 8:30AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on 703-305-1830. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7238 for regular communications and 703-746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-2345.

LH

Lee R. Huynh
July 14, 2003


GILBERTO BARRON
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